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David M. Quinlan, P.C.
32 Nassau Street
Suite 300
Princeton NJ 08542

In re Application of:
MONTGOMERY, Eric, R.
U.S. Application No.: 10/568,054
PCT No.: PCT/US2004/024070
International Filing Date: 28 July 2004
Priority Date: 28 July 2003
Attorney's Docket No.: 7800B.8005
For: COMPOSITIONS, METHODS,
DEVICES AND KITS FOR
MAINTAINING OR ENHANCING
TOOTH WHITENING

DECISION ON PETITION UNDER
37 CFR 1.47(b)

This decision is issued in response to the "Petition Pursuant To PCT Article 14 Rule 4.15(b)" filed 06 October 2006, treated herein as a petition under 37 CFR 1.47(b) for acceptance of the application without the signature of the sole inventor. Applicant has been charged the required \$200 petition fee.

BACKGROUND

On 28 July 2004, applicant filed international application PCT/US2004/024070. The application claimed a priority date of 28 July 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 28 January 2006.

Applicant did not file the basic national fee prior to the expiration of the thirty-month deadline. Accordingly, the present application became abandoned at midnight on 28 January 2006.

On 10 February 2006, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a petition for revival of the international application under 37 CFR 1.137(b).

On 28 February 2006, this Office issued a decision granting the petition for revival under 37 CFR 1.137(b).

On 06 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or

declaration in compliance with 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, and additional claims fees totaling \$6,110 were required.

On 06 October 2006, petitioner filed a response to the Notification Of Missing Requirements. The response included payment of the required surcharge and extra claims fees, as well as the petition considered herein. The petition seeks acceptance of the application without the signature of the sole inventor, whom petitioner states has refused to execute the application papers.

It is noted that the petition refers to PCT Rule 4.15(b), which applies to acceptance of an international application without an inventor's signature; however, PCT Rule 4.15(b) does not apply to the signature requirement in a U.S. national stage application. Rather, where, as here, it is claimed that a sole inventor refuses to execute the declaration in a U.S. national stage application, the applicable regulation is 37 CFR 1.47(b). The petition has therefore been treated under this regulation.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present submission satisfies item (1).

Regarding item (1), petitioner has been charged the required \$200 petition fee. Item (1) is therefore satisfied.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP states that a "copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided copies of email communications apparently involving attempts to obtain the signature of the non-signing inventor. However, petitioner has not provided a firsthand statement from any of the persons involved in this correspondence, as necessary to confirm and clarify the context of this correspondence and the contents of the attachments thereto. Without clarifying firsthand statements, the email messages provided do not support a conclusion that the inventor has refused to execute the application papers (for example, who is Maria Woodrow, what specifically was Naomi Brickey requesting of her on 27 September 2006, and what, if any, response was received from her?) Petitioner has also not provided the required firsthand statement (with documentary support) confirming that a request for signature, accompanied by a copy of the complete application papers, has been forwarded to the non-signing at his last known

address, as required before a refusal to sign can be presumed. Based on the above, item (2) is not satisfied.

Regarding item (3), the petition does not include an express statement of the last known address of the nonsigning inventor. Item (3) is therefore not satisfied.

Regarding item (4), the petition does not include an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor. Item (4) is therefore not satisfied on the present record.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Here, it appears that the 37 CFR 1.47(b) applicant is Britesmile Professional, Inc., (Britesmile Professional), and that the assertion of proprietary interest is based on a chain of assignments. With respect to such a claim, the MPEP states the following:

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324).

The present petition includes a copy of an assignment apparently transferring rights in the present application from Britesmile, Inc. (Britesmile) and Britesmile Development, Inc. (Britesmile Development) to Britesmile Professional. However, the petition does not include evidence that the inventor assigned the application to either Britesmile or Britesmile Development. The petition therefore does not include the required evidence confirming a chain of title from the inventor to the 37 CFR 1.47(b) applicant. In addition, the petition does not include a statement under 37 CFR 3.73(b) that properly references previously recorded assignments or has copies of the relevant assignments attached thereto.¹ Accordingly, the present submission does not adequately demonstrate the required proprietary interest of the 37 CFR 1.47(b) applicant. Item (5) is therefore not satisfied on the present record.

¹ It is noted that statements under 37 CFR 3.73(b) statement were previously filed in this application on behalf of Britesmile Professional. However, the forms did not properly reference any recorded assignments herein, and it does not appear that copies of any such assignments were attached to the 3.73(b) statements. Accordingly, such statements are not effective for purposes of this petition, or for the purpose of changing the correspondence address of record herein.

Regarding item (6), the petition does not include the required express statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is therefore not satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy items (2), (3), (4), (5), and (6) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

A courtesy copy of this decision will be mailed to the address listed on the present petition; however, as discussed above, until a properly supported statement under 37 CFR 3.73(b) is submitted, petitioner's previously filed requests to change the correspondence address of record cannot be granted. The correspondence address of record herein therefore remains the address listed above.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273- 0459

cc:

NANCY QUAN
Britesmile Professional, Inc.
8550 Higuera Street
Culver City, CA 90232